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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/327,107	06/07/1999	BROOK LANG	LANB-101	5045

7590 07/29/2004  
DEAN A CRAINE  
CRAINE ASSOCIATES INC  
400 112TH AVENUE N E SUITE 140  
BELLEVUE, WA 98004

EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/327,107

Applicant(s)

LANG, BROOK

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,13,14,16,17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,13,14,16,17 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Non- Final Action**

1. The request for a continued prosecution application (CPA) under 37 CFR 1.53(d) filed on April 21, 2004 is acknowledged. 37 CFR 1.53(d)(1) was amended to provide that the CPA must be for a design patent and the prior application of the CPA must be a design application that is complete as defined by 37 CFR 1.51(b). See *Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications*, final rule, 68 *Fed. Reg.* 32376 (May 30, 2003), 1271 *Off. Gaz. Pat. Office* 143 (June 24, 2003). Since a CPA of this application is not permitted under 37 CFR 1.53(d)(1), the improper request for a CPA is being treated as a request for continued examination of this application under 37 CFR 1.114.

This Office Action is responsive to the above Request for Continued Prosecution Application (CPA), the Request for Extension of time, and Preliminary Amendment mailed April 21, 2004.

Amendments to claims 1, 4, 7, 13, 14, 16, 17, 19 have been entered.

Thus claims 1, 3-4, 7, 13, 14, 16, 17, 19 remain pending and herein examined.

**Due to the amendments, the previous rejections are withdrawn and new ones are applied.**

**Claim Rejections - 35 USC § 112(2)**

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

As to claim 19: withdrawn.

**3. Claims 7 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 7. There seems to be a typographical error. "Step c)" in this claim should be "step d)". Correction is required.

Claim 16 should be dependent on claim 1 as claim 15 has been cancelled.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**5. Claims 1, 3-4, 7, 13, 14, 16, 17, 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Tso et al., US 6047327, herein Tso.**

Claim 1.

Tso discloses:

A method of marketing to a mobile user of an electronic device,

comprising the following steps:

- a. selecting an electronic device connected to a wireless communication device capable of connecting to a computer wide area network (see at least abstract) ;
- b. selecting a server (see at least Fig. 2 and associated text, col. 4 lines 34-col. 5 line 32 ) connected to said computer wide area network;
- c. determining the physical location (see at least col. 1 lines 44-52 )of said electronic device when said electronic device is connected to said computer wide area network and transmitting said physical location information to said server;
- d. determining the network identity information of said electronic device when connected and transmitting said network identity information to said server (see at least col. 17 lines 1-14).
- e. creating a user file on said server containing said network identity information for said electronic device, said physical location information of said electronic device, when connected to said wide area network (implied) ;
- g. reviewing said user file to determine if said electronic device is within a target advertising region of an advertiser (see at least Fig. 2 and associated text, col. 4 lines 34-col. 5 line 32 );
- h. selecting advertising material to be sent to said electronic device moving within the target advertising region (see at least Fig. 2 and associated text, col. 4 lines 34-col. 5 line 32 ); and,
- i. transmitting without a request from the user (see at least col. 1 lines 8-11; lines 44-52) said advertising material to said electronic device when said electronic device is connected to said computer wide area network and moving through the target advertising region.

Claim 3 (dependent on claim 1): Tso further discloses the step (b) of determining the physical location of said electronic device is accomplished using a global positioning satellite system which provides global coordinate information of said electronic device when connected to said wide area network (see at least col. 16 lines 44-49).

Claim 4 (dependent on claim 1): Tso further discloses step c) is carried out by a wireless modem connected to said electronic device and used to communicate with said wireless telephone network, said wireless telephone network capable of determining the physical location of said wireless modem when connected to said wireless telephone network and moving throughout the region served by said wireless telephone network (see at least Fig. 2 and associated text; col. 4 lines 8-14).

Claim 7 (dependent on claim 1): Tso further discloses determining the web sites visited by a user of said electronic device (see at least Fig. 5 and associated text: when the user browser displays an item of information sent, a visited website is determined. It is noted Applicants do not claim what is done with this visited website determination).

Claim 13 (dependent on claim 1): Tso further discloses determining the physical location of said electronic device is carried out when said electronic device is connected to said computer wide area network (see at least col. 17 lines 11-14).

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Claim 14 (dependent on claim 1): Tso further discloses determining the physical location of said electronic device is carried out by a cellular telephone system capable of determining the physical location of a cellular telephone used to connect to said computer wide area network (see at least col. 4 lines 8-14; Fig. 2 and associated text).

Claims 16 and 17 (dependent on claim 1): Tso further discloses determining the network identity information of said electronic device is accomplished by using client software program loaded into said electronic device to transmit said network identity information to said server or by determining the numerical network address assigned to said electronic device by said server when connected to said computer wide area network (see at least col. 17 lines 1-14).

Claim 19 (dependent on claim 1): Tso further discloses said user file containing personal data of said user of said electronic device (see at least col. 4 lines 34-43).

### **Conclusion**

6. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Malec et al., US 5,295,064, discloses intelligent shopping cart system.

Vela et al., US 5,630,068 discloses shoppers communication system based on physical location.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The

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Examiner works a part-time schedule and can best be reached on Tuesday-Wednesday 9:00-6:00.

The examiner can also be reached at the e-mail address: [khanh.le2@uspto.gov](mailto:khanh.le2@uspto.gov). ( However,

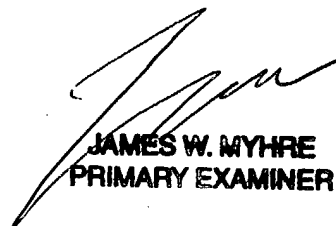
Applicants are cautioned that confidentiality of email communications cannot be assured.)

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

July 26, 2004

KHL



**JAMES W. MYHRE**  
**PRIMARY EXAMINER**